

AMENDMENTS TO THE DRAWINGS

In Figure 2, one of the two reference number 21s is changed to 25. One Annotated Sheet and one Replacement Sheet are enclosed.

REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed January 24, 2006. Claims 1-69 are cancelled without prejudice or disclaimer and new claims 70-99 are added. As a result, claims 70-99 are currently pending. Applicants traverse all of the rejections in the Office Action and respectfully request reconsideration and passage of the claims to allowance for the following reasons.

Claims Patentable over Herz under §102

The Office Action rejected claims 22-25, 28, 32-37, 42, 45-47, 50, 52, 54, 56, 57, 59, 64 and 67-69 under 35 U.S.C. §102(a/e) as being anticipated by U.S. Patent No. 6,088,722 to Herz et al. ("Herz").

According to MPEP §2131, to anticipate a claim under §102, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The rejection of cancelled claims 22-25, 28, 32-37, 42, 45-47, 50, 52, 54, 56, 57, 59, 64, and 67-69 is moot. New claims 70-99 are patentable over Herz under §102, because Herz fails to disclose each element in the claimed invention. For example, Herz fails to disclose the claimed dynamic campaign manager for defining the

advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign.

Claim 70 recites, *inter alia*, “a dynamic campaign manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. The claimed invention is directed to providing a service for advertisers, not customers like Herz. By contrast, Herz is generally directed to a system and method for determining from objective profile data of the customers which data or video programming is most desired by each customer so that the customers may receive data or video programming customized to their objective preferences. (See Herz, abstract, col. 1, lines 19-24.) Thus, Herz is customer centric, while the claimed invention is advertiser centric. Herz discloses providing content that is most desired by customers, while the claimed invention is generally directed to managing successful advertising campaigns. Even though Herz discloses targeted advertising, no dynamic campaign manager is disclosed. (See Herz, col. 30, lines 33-38.) Herz discloses combining the customer preferences with demographics and profiles to provide targeted advertising in a static, ad hoc manner, without any management of an advertising campaign or feedback on an advertising campaign. Herz fails to disclose any advertising campaign, as claimed.

Therefore, claim 70 is patentable over Herz under §102.

Claims 71-84 depend, directly or indirectly, from claim 70 and, thus, inherit the patentable subject matter of claim 70, while adding additional elements. Therefore, claims 71-84 are also patentable over Herz under §102.

Claim 85 recites, *inter alia*, “dynamically managing the advertising campaign by defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. For the same reasons given above with respect to claim 70, claim 85 is also patentable over Herz under §102.

Claims 86-99 depend, directly or indirectly, from claim 85 and, thus, inherit the patentable subject matter of claim 85, while adding additional elements. Therefore, claims 86-99 are also patentable over Herz under §102.

Claims Patentable over Herz/Hendricks under §103

The Office Action rejected claims 1-4, 9-11, 17, 18, 30, 31 and 51 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 5,659,350 to Hendricks et al. ("Hendricks").

According to MPEP §2143, to establish a *prima facie* case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action failed to establish a *prima facie* case of obviousness, because the combination of Herz and Hendricks fails to teach or suggest all the claim elements for at least the following reasons. For example, the combination fails to teach or suggest the claimed dynamic campaign manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign.

The rejection of cancelled claims 1-4, 9-11, 17, 18, 30, 31, and 51 is moot. New claims 70-99 are patentable over the combination of Herz and Hendricks under §103 for the following reasons.

Claim 70 recites, *inter alia*, "a dynamic campaign manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign". The claimed invention provides dynamic campaign management. By contrast, Hendricks is generally directed to an operations center for television entertainment systems that provide television programming to consumer homes. (See Hendricks, abstract.) Hendricks discloses an operations center that inserts directions for filling local available program time in a packaged signal to enable local cable and television companies to fill the program time with local advertising and/or local programming. (See Hendricks, col. 8, lines 4-8.) Like Herz, Hendricks discloses providing advertising in a static, ad hoc manner, without any management of

an advertising campaign or feedback on an advertising campaign. As discussed above, Herz fails to disclose a dynamic campaign manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign, as claimed.

Therefore, claim 22 is patentable over the combination of Herz and Hendricks under §103.

Claims 71-84 depend, directly or indirectly, from claim 70 and, thus, inherit the patentable subject matter of claim 70, while adding additional elements. Therefore, claims 71-84 are also patentable over the combination of Herz and Hendricks under §103.

Claim 85 recites, *inter alia*, “dynamically managing the advertising campaign by defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. For the same reasons given above with respect to claim 70, claim 85 is also patentable over the combination of Herz and Hendricks under §103.

Claims 86-99 depend, directly or indirectly, from claim 85 and, thus, inherit the patentable subject matter of claim 85, while adding additional elements. Therefore, claims 86-99 are also patentable over the combination of Herz and Hendricks under §103.

Claims Patentable over Herz/Hendricks/Strubbe under §103

The Office Action rejected claims 5-8 under 35 U.S.C. §103(a) as being unpatentable over Herz and Hendricks in view of U.S. Patent No. 5,223,924 to Strubbe (“Strubbe”).

The rejection of cancelled claims 5-8 is moot. New claims 70-99 are patentable over the combination of Herz, Hendricks and Strubbe under §103 for the following reasons.

As discussed above, the combination of Herz and Hendricks fails teach or suggest the claimed dynamic campaign manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising

campaign. Furthermore, Strubbe fails to teach or suggest at least these claimed elements.

Claim 70 recites, *inter alia*, “a dynamic campaign manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. By contrast, Strubbe discloses creating a customized TV program database, containing only programs of interest to the viewer, and displaying this information as part of the television display. (See Strubbe, col. 2, lines 6-9.) Thus, Strubbe, like Herz, is customer centric, while the claimed invention is advertiser centric. Strubbe also fails to disclose the claimed advertising campaign.

Therefore, claim 22 is patentable over the combination of Herz, Hendricks and Strubbe under §103.

Claims 71-84 depend, directly or indirectly, from claim 70 and, thus, inherit the patentable subject matter of claim 70, while adding additional elements. Therefore, claims 71-84 are also patentable over the combination of Herz, Hendricks and Strubbe under §103.

Claim 85 recites, *inter alia*, “dynamically managing the advertising campaign by defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. For the same reasons given above with respect to claim 70, claim 85 is also patentable over the combination of Herz, Hendricks and Strubbe under §103.

Claims 86-99 depend, directly or indirectly, from claim 85 and, thus, inherit the patentable subject matter of claim 85, while adding additional elements. Therefore, claims 86-99 are also patentable over the combination of Herz, Hendricks and Strubbe under §103.

Claims Patentable over Herz/Gerace under §103

The Office Action rejected claims 12-16 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 5,848,396 to Gerace (“Gerace”).

The rejection of cancelled claims 12-16 is moot. New claims 70-99 are patentable over the combination of Herz and Gerace under §103 for the following reasons. As discussed above, Herz fails to teach or suggest a dynamic campaign

manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign, as claimed. Furthermore, Gerace also fails to teach or suggest at least these claimed elements.

Claim 70 recites, *inter alia*, “a dynamic campaign manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. Gerace discloses a data assembly for displaying customized agate information to a computer user and a tracking and profiling member for recording user activity. (See Gerace, col. 2, lines 7-11.) The data assembly transmits targeted advertisements based on user profiles based on demographics recorded by the tracking and profiling member. (See Gerace, col. 2, lines 30-34.) A subroutine performs regression analysis on the recorded history of users and refines the user profiles based on the regression analysis. (See Gerace, col. 2, lines 43-46.) Thus, Gerace merely refines user profiles. However, in contrast to the claimed invention, Gerace fails to teach or suggest the claimed dynamic campaign manager or the claimed advertising campaign. Gerace discloses targeted advertising in an ad hoc manner, without any management of an advertising campaign or feedback on an advertising campaign, as claimed. Gerace is focused more on the customers than on the advertisers.

Therefore, claim 22 is patentable over the combination of Herz and Gerace under §103.

Claims 71-84 depend, directly or indirectly, from claim 70 and, thus, inherit the patentable subject matter of claim 70, while adding additional elements. Therefore, claims 71-84 are also patentable over the combination of Herz and Gerace under §103.

Claim 85 recites, *inter alia*, “dynamically managing the advertising campaign by defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. For the same reasons given above with respect to claim 70, claim 85 is also patentable over the combination of Herz and Gerace under §103.

Claims 86-99 depend, directly or indirectly, from claim 85 and, thus, inherit the patentable subject matter of claim 85, while adding additional elements. Therefore, claims 86-99 are also patentable over the combination of Herz and Gerace under §103.

Claims Patentable over Herz/Hendricks under §103

The Office Action rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of Hendricks.

The rejection of cancelled claim 19 is moot. As discussed above, new claims 70-99 are patentable over the combination of Herz and Hendricks under §103.

Claims Patentable over Herz/Strubbe under §103

The Office Action rejected claim 20 under 35 U.S.C. §103(a) as being unpatentable over Herz and Hendricks in view of Strubbe.

The rejection of cancelled claim 20 is moot. New claims 70-99 are patentable over the combination of Herz and Strubbe under §103. As discussed above, new claims 70-99 are patentable over the combination of Herz, Hendricks, and Strubbe under §103. Therefore, they are also patentable over the combination of Herz and Strubbe under §103.

Claims Patentable over Herz under §103

The Office Action rejected claims 26, 27, 29, 41, 43, 44, 49, 53, 55, 58, 60-62, 65, and 66 under 35 U.S.C. §103(a) as being unpatentable over Herz.

The rejection of cancelled claims 26, 27, 29, 41, 43, 44, 49, 53, 55, 58, 60-62, 65, and 66 is moot. As discussed above, new claims 70-99 are patentable over Herz under §102 and, therefore, new claims 70-99 are also patentable over Herz under §103 for the same reasons.

Claims Patentable over Herz/Barrett under §103

The Office Action rejected claims 38-40 and 48 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 6,005,597 to Barrett et al. ("Barrett").

The rejection of cancelled claims 38-40 and 48 is moot. New claims 70-99 are patentable over the combination of Herz and Barrett under §103 for the following reasons. As discussed above, new claims 70-99 are patentable over Herz under §102

and §103. Furthermore, Barrett fails to teach or suggest the claimed dynamic campaign manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign.

Claim 70 recites, *inter alia*, “a dynamic campaign manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. By contrast, Barrett discloses a method and apparatus for television program selection that monitors the viewing preferences of a viewer to create a dynamic viewer profile that is used to rate available programs and, based on the viewer profile, available programs are sorted and presented to the viewer in descending order of predicted interest. (See Barrett, abstract.) Again, Barrett is more concerned with providing programming of interest to the viewer, than in managing an advertising campaign as claimed.

Therefore, claim 22 is patentable over the combination of Herz and Barrett under §103.

Claims 71-84 depend, directly or indirectly, from claim 70 and, thus, inherit the patentable subject matter of claim 70, while adding additional elements. Therefore, claims 71-84 are also patentable over the combination of Herz and Barrett under §103.

Claim 85 recites, *inter alia*, “dynamically managing the advertising campaign by defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. For the same reasons given above with respect to claim 70, claim 85 is also patentable over the combination of Herz and Barrett under §103.

Claims 86-99 depend, directly or indirectly, from claim 85 and, thus, inherit the patentable subject matter of claim 85, while adding additional elements. Therefore, claims 86-99 are also patentable over the combination of Herz and Barrett under §103.

Claims Patentable over Herz/Ozer under §103

The Office Action rejected claim 63 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 6,708,335 to Ozer et al. (“Ozer”).

The rejection of cancelled claim 63 is moot. New claims 70-99 are patentable over the combination of Herz and Ozer under §103 for the following reasons.

Claim 70 recites, *inter alia*, “a dynamic campaign manager for defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. Ozer is generally directed to a system and method for tracking the viewing of an advertisement by recognizing an identifying marker that has been placed in the advertisement. (See Ozer, col. 1, lines 9-16.) This enables advertisers to verify that advertisements have been broadcast as expected. (See Ozer, col. 2, lines 42-44.) Ozer discloses tracking, storing, and transmitting viewing behavior to a clearinghouse system. (See Ozer, col. 3, lines 36-42.) However, Ozer fails to teach or suggest the claimed dynamic campaign manager. Ozer is static, not dynamic. Ozer merely provides static information without providing any means for modifying an advertising campaign, as claimed. In addition, while Ozer discloses tracking the viewing of an advertisement, Ozer fails to disclose any advertising campaign or the management of it.

Therefore, claim 22 is patentable over the combination of Herz and Ozer under §103.

Claims 71-84 depend, directly or indirectly, from claim 70 and, thus, inherit the patentable subject matter of claim 70, while adding additional elements. Therefore, claims 71-84 are also patentable over the combination of Herz and Ozer under §103.

Claim 85 recites, *inter alia*, “dynamically managing the advertising campaign by defining the advertising campaign, modifying the advertising campaign, and providing feedback on the advertising campaign”. For the same reasons given above with respect to claim 70, claim 85 is also patentable over the combination of Herz and Ozer under §103.

Claims 86-99 depend, directly or indirectly, from claim 85 and, thus, inherit the patentable subject matter of claim 85, while adding additional elements. Therefore, claims 86-99 are also patentable over the combination of Herz and Ozer under §103.

CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and passage of the claims to allowance. If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Lea A. Nicholson or Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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Eamon J. Wall, Attorney
Reg. No. 39,414
(732) 530-9404

Patterson & Sheridan, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702